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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,516	11/21/2003	Yiwen Tang	50623.304	3018
Victor Repkin Squire, Sanders & Dempsey L.L.P. 1 Maritime Plaza, Suite 300 San Francisco, CA 94111			EXAMINER ROGERS, JAMES WILLIAM	
			ART UNIT	PAPER NUMBER
			1618	
			MAIL DATE	DELIVERY MODE
			01/08/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/719,516

**Applicant(s)**

TANG ET AL.

**Examiner**

JAMES W. ROGERS

**Art Unit**

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-8, 11-18, 20, 21, 23-25 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 11-18, 20, 21, 23-25 and 28-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

Claims 1-4,6-8,11,15,17-18,20-21,23-25,28 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (WO 01/21229 A1), for the reasons set forth in the office action mailed 04/18/2008.

Claims 1-3,6-8,11-18,20,23-25,28-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Hossainy et al. (EP 0 970,711 A2), for the reasons set forth in the office action mailed 04/18/2008.

Claims 1-3,6-8,11,15,17-18,20,23-25,28 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by DeSimone et al. (US 2004/0181271 A1), for the reasons set forth in the office action mailed 04/18/2008.

Claims 1-3,6-8,11,15,17-18,20,23-25,28 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Hossainy et al. (US 2001/0014717 A1, '717 from hereon), for the reasons set forth in the office action mailed 04/18/2008.

Applicant's arguments filed 07/18/2008 have been fully considered but they are not persuasive.

Applicants assert that Lee, DiSimone, Hossainy and, '717 cannot anticipate their claims because none of the references recite every feature of their claimed invention. Applicants assert that none of the references describe the polymers as having the same Tg or degree of crystallization presently claimed for the first polymer and polymeric additive. In order to bolster their argument applicants submitted two references which they purport support their argument that the degree of crystallinity can be different for a

particular polymer and depends upon the conditions under which the polymer was made.

The relevance of these assertions is unclear. As detailed in previous office actions it is the position of the examiner that since the polymers taught in the references above are the same as applicants claimed polymers (PCL, PLA and PGA) they will inherently have the same properties including  $T_g$  and degree of crystallization. Applicants have not set forth in their claims or within the specification how their polymers would have a different degree of crystallization and  $T_g$  than those same polymers known in the art or that are commercially available. The references presented by applicants do indeed show that polymers with different molecular weights (size) and particle sizes do exhibit different degrees of crystallization, however applicants have not recited within their claims any physical feature of the polymers (MW or particle size) that would exclude the polymers within the references above. The examiner can only search for what is claimed, since the polymers claimed are within the same in scope as what is described in the references above the examiner assumes that any property derived from those polymers is also necessarily the same. All of the applied references above teach the same coatings comprised of the same polymeric blends as claimed by applicants e.g. PCL and PHB. The polymers disclosed in those references also either recite or inherently teach the same  $T_g$  as claimed by applicants. It is well known in the art that the glass transition temperature  $T_g$  and the melting temperature  $T_m$  of a polymer is inherently linked to its crystalline structure. See Odian Principles of polymerization pp 24-33, cited previously. Thus it is the position of the examiner that since the polymers

claimed are the same and their  $T_g$  values are the same the polymers will inherently have the same degree of crystallization as applicants claimed polymer blend because crystallinity and glass transition temperatures are inherently linked. Also applicants own specification at [0035] of the US PGPUB 20050112171 A1 states "the crystallinity of 3-PHB is about 80% while that of PCL is about 57%" thus as evidenced from applicants own specification it would appear that inherently 3-PHB (described as an additive) has a higher degree of crystallinity then PCL (described as a 1<sup>st</sup> polymer), thus since all of the above references teach blends of PCL and PHB the limitation is inherently met. It appears as though applicants are trying to claim an undisclosed or unknown property of an old polymeric blend. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable.

### ***Conclusion***

No claims are allowed at this time.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/

Supervisory Patent Examiner, Art Unit 1618